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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,326	11/07/2001	Richard Tiffin	RTIFFIN-1X	1491

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EXAMINER	
LEGESSE, NINI F	

ART UNIT	PAPER NUMBER
3711	

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/039,326	TIFFIN, RICHARD	
	Examiner	Art Unit	
	Nini F. Legesse	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 June 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7,11 and 20-29* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7, 11, 20-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Applicant's response to the Office Action of 01/07/04 is acknowledged on 06/09/04.

Claim identifier missing

Claims 2-9 and 11 are missing status identifier.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 25-29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The expression "said firm support layer is significantly more rigid than said mark retaining layer" is new matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Perrine (US Patent No. 5,984,802).

With respect to claims 1 and 2, Perrine discloses a golf swing practice mat (110) comprising:

- A firm support layer (150, see also col. 6 lines 45+);
- Mark retaining surface means (112, item 112 is clearly capable of "recording" an impression when hit by a golf club with emphasis on resilient surface 114; see also col. 6, lines 24-32);
- Retaining means (see column 6, lines 45+);
- Rubber mat (114).

With respect to claims 20, Perrine discloses the invention as recited above and in column 6, lines 48 it is stated that the retaining surface is fastened to the bottom element indicating that this surface is removable.

Claims 4, 5, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Perrine.

Perrine discloses Wherein said rubber mat is secured to said firm support layer by adhesives (column 5, lines 39-40 indicate that the bottom pad and the top sheet could be adhesively bonded); and wherein said firm support layer (150) includes a

substantially planar sheet of plastic (column 6, lines 45-62 indicate that strip 150 could be plastic material);

Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by Perrine.

Perrine discloses wherein said mark retaining surface means comprise a wax containing surface (column 6, line 27).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 3 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perrine.

Perrine discloses the invention as recited above but fails to explicitly state wherein the rubber mat is secured to the firm support layer by adhesive tape. However, Perrine teaches that the base element and the mat could be secured with a screw or could be thermally or adhesively bonded (column 5, lines 34-41). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use an adhesive tape since it was known in the art that an adhesive tape could easily secure different elements together.

Claims 6, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perrine.

Perrine teaches that the top sheet (12, 112) has a completely smooth and very low-friction surface that is made of a suitable type plastic (column 6, lines 44-46). However, he fails to teach that this planar sheet of plastic to be polycarbonate plastic and the retaining means to comprise fastening dowels. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the apparatus of Perrine with polycarbonate plastic or any other compatible plastic since Applicant has not shown the criticality for the claimed polycarbonate element. It appears that the practice mat of Perrine would accomplish similar purpose. And those skilled in the art may use a variety of plastics for the top sheet without departing from the spirit and scope of Perrine's invention.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Perrine in view of Manheck (US patent No. 3,754,764).

Perrine discloses wherein the mark retaining means (12, 112) has a visible substance like household spray-wax, or foamy soap solution to be applied to it to register the actual path of a golf club's head passing thought the hitting area when the club head is in contact with the top sheet (column 6, lines 24-32). These elements appear to be no carbon elements. Perrine also discloses the use of multiple ball positions (30) on the mat (column 5, lines 65-67). However Perrine fails to teach the presence of a sheet of no carbon paper. However, Manheck teaches about no carbon paper (column 2, lines 14-32). It would have been obvious to one having ordinary skill in the art at the time the

invention was made to provide a no carbon paper as taught by Manheck in the Perrine device in order to register the actual path of a golf club's head when a club head is in contact with a top sheet as a player swings his golf club. With the use of a no carbon paper the player could be able to save his swing marks of different days so that he could easily keep record of his progress with time.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Perrine in view of Grossman (US patent No. 2,660,436).

Perrine discloses that markings are provided on the top sheet for ball positions (column 5, lines 42-50). He also teaches that the top sheet (12, 112) to have a visible substance line household spray-wax, or foamy soap solution to be applied to it to register the actual path of a golf club's head passing thought the hitting area when the club head is in contact with the top sheet (column 6, lines 24-32). However Perrine fails to teach the presence of a sheet of carbon paper. However, Grossman teaches about carbon paper (41). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a carbon paper as taught by Grossman in the Perrine device in order to register the actual path of a golf club's head when a club head is in contact with a top sheet as a player swings his golf club. With the use of a carbon paper the player could be able to save his swing marks of different days so that he could easily keep record of his progress with time.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Perrine in view of Miller (US patent No. 5,028,052).

Perrine as discussed above discloses a firm support layer (150, see also col. 6 lines 45+); a mark retaining surface means (112, item 112 is clearly capable of "recording" an impression when hit by a golf club with emphasis on resilient surface 114; see also col. 6, lines 24-32); a retaining means (see column 6, lines 45+); and a rubber mat (114). However, for sake of discussion, if one believes that the Perrine's reference is different than the instant invention in that item 150 could not be considered a support layer and that the rubber mat element is to be secured to the bottom of the support layer, then the teaching of the Miller reference can be combined with the Perrine's reference. Miller discloses base member (10, col. 2, line 50 indicates the base member to be polycarbonate material) that is positioned between a golf ball hitting surface (20) and a base member (10). In addition, the Miller reference includes rubber-like supports/mats (14) that are adhesively bonded to the base (col. 2, lines 60-61). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide different arrangement of golf mat components as taught by Miller in the Perrine's device in order to provide the feel of natural turf as the club head strikes a golf ball placed on hitting surface.

Claims 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perrine.

With respect to claim 25, refer to the limitation as addressed in claim 1. Perrine does not indicate wherein the support layer is more rigid than the mark-retaining layer. However, at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to provide a variety type of support

layer because Applicant has not disclosed that more rigid support layer provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the, furthermore, would have expected Applicant's invention to perform well with the support layer as taught by Perrine.

With respect to claim 26, refer to the rejections made for claims 3 and 21 above.

With respect to claim 27, refer to the rejections made for claim 4 above.

With respect to claims 28 and 29, refer to the rejections made for claim 6 above.

Response to Arguments

Applicant's argues that Perrine does not teach an easy removal of the mark retaining layer, however in column 6, lines 48, of the Perrine reference, it is stated that the retaining surface is fastened to the bottom element indicating that this surface is removable.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nini F. Legesse whose telephone number is (703) 605-1233. The examiner can normally be reached on 9:30 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vidovich Greg can be reached on (703) 308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NFL
09/15/04

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